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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,279

01/16/2004

Brian Dean Edamura

14591

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7590

09/08/2005

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/758,279

Applicant(s)

EDAMURA, BRIAN DEAN

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Elwert et al (US 4,351,435; hereinafter Elwert).

Claim 1: Elwert discloses a drill bit container **10** comprising a body **11** having elongated channels **19** aligned in a row (see Figure 4) with an opening at one end, and slidable closure **34** having openings **40 & 41** for selectively opening and closing the channels.

Claim 7: Elwert discloses second row of channels **20** arranged as claimed (see Figure 4).

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Pavel (US 4,116,333).

Claim 1: Pavel discloses a container comprising a body **1** having elongated channels **2** aligned in a row (see Figure 4) with an opening at one end, and slidable closure **11** having opening **17** for selectively opening and closing the channels. Pavel is inherently capable of retaining drill bits.

Claim 2: body 1 is disk shaped and the row of channels 2 is generally arcuate (see Figure 3).

Claim 3: Pavel discloses aperture 28, which is capable of functioning as a handle.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavel as applied to claim 3 above, and further in view of Elwert.

Claim 4: Pavel discloses the claimed invention except for the second row of channels.

Elwert discloses two adjacent rows of channels **19 & 20** for accommodating articles of differing diametrical series (see for example, Col. 5, lines 55-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Pavel with a second row of channels as taught by Elwert in order to accommodate a differing diametrical series of articles.

Claims 7 and 8: the container of Pavel-Elwert, as applied to claim 4 above, discloses the claimed invention.

4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavel-Elwert as applied to claim 4 above, and further in view of Pond (US 5,139,143).

Claim 5: Pavel-Elwert discloses the claimed invention except for the rubber bumpers.

Pond discloses rubber pads **57** disposed on the exterior of the container for slide prevention and scuff protection (see Col. 3, lines 7-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Pavel-Elwert with rubber pads as taught by Pond in order to prevent container sliding when placed on a surface and scuff protection.

Claim 6: the examiner takes Official Notice that the placement of rubber on an article handle was common and conventional in the container art, such placement used for improving grip and comfort when using the handle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle of Pavel-Elwert-Pond with a rubber covering in order to improve its grip and comfort.

Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the Official Notice.

See In Re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Pickett  
Examiner  
2 September 2005



ANTHONY D. STASHICK  
PRIMARY EXAMINER